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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/575,776 05/22/00 HENRY

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000164  
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MMC2/0727

EXAMINER

VORTMAN, A

ART UNIT

PAPER NUMBER

2835

DATE MAILED:

07/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/575,776

Applicant(s)

HENRY, CHERYL

Examiner

Anatoly Vortman

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the printer, which is "an attachable unit" recited in claim 8 and "an additional drive component" recited in claim 9, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### *Claim Objections*

2. Claims 1, 2, and 4-6 are objected to because of the following informalities: claims recite the clause "capable of". It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not provide the adequate support for the embodiment of the device containing a plurality of drive components capable of reading different types of data storage media as claimed in claim 9. The specification only briefly mentions that the embodiment depicted on Fig. 1 (shown accepting only the optical media) is actually capable of accepting and reading a magnetic media (a diskette), (page 5, lines 7+).

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 8, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,566,290 to Silverbrook.

Regarding claims 1 and 6, Silverbrook disclosed (Fig. 1 and 2) a portable apparatus (1) for reading file information stored on a separately portable self contained data storage device (11), the portable apparatus not in communication with a personal computer, the apparatus comprising:

A housing (2, 9) of a size and weight capable of being held in a person's hand;  
a drive component (79) for reading the file information on the data storage device (11),  
(column 2, lines 4+);  
a loading mechanism (79) for receiving the data storage device (11) and retaining the data  
storage device such that the drive component (79) reads the file information on command  
(column 2, lines 4+); and  
a visual display (4) operably connected to the drive component for viewing the file  
information contained on the data storage device (11).

Regarding claim 6, Silverbrook further disclosed a printer operably connected to the  
drive component and capable of printing the file directory contents contained on the display (4),  
(column 3, lines 45+).

Regarding claim 2, Silverbrook disclosed a printer (column 3, lines 45+) capable of  
printing the file information retrieved from the data storage device (11) by the drive component  
(79).

Regarding claim 3, Silverbrook disclosed that the visual display (4) is a liquid crystal  
display (column 1, line 66).

Regarding claim 4, Silverbrook disclosed that the drive component is capable of reading  
magnetic storage media (78), (column 4, lines 9+).

Regarding claim 5, Silverbrook disclosed that the drive component is capable of reading  
optical storage media (column 2, lines 4+).

Regarding claim 8, Silverbrook disclosed that the printer is an attachable unit (column 3,  
lines 45+).

Regarding claims 10-12, the method steps recited in the claims are necessitated by the device structure as disclosed by Silverbrook.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook.

Regarding claim 7, Silverbrook disclosed all of the claim's limitations as apply to claim 6, but did not disclose that the printer is located within the housing. The official notice is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate said printer within the apparatus housing in order to enhance the versatility of the device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

*Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

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US/ 5822190, 6015093, 5555157, 6016248, 5596350, 5778256, 4633323, 4639225, 5331423, 5666438, 5612732, 5528285, 5892502, 5651681, 5604551, and 5574625 disclosed electronic devices for reading various data storage media and displaying the information.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard can be reached on 703-308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman  
Examiner  
Art Unit 2835

A.V.  
July 9, 2001

